



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: L. James Hwang
Assignee: Xilinx, Inc.
Title: METHOD AND SYSTEM FOR TIME-STAMPING AND MANAGING
ELECTRONIC DOCUMENTS
Serial No.: 09/307,620 File Date: May 7, 1999
Examiner: Stephen S. Hong Art Unit: 2178
Docket No.: X-409 US Conf. No.: 5100

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APPEAL BRIEF

Sir:

This is an Appeal Brief submitted pursuant to 37 C.F.R. § 1.192 for the above-referenced patent application and is being filed in triplicate.

I. Real Party in Interest

The real party in interest is Xilinx, Inc., having a place of business at 2100 Logic Drive, San Jose, CA 95124-3400. The above referenced patent application is assigned to Xilinx, Inc.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1-21 are presented for appeal.

Claims 1-21 stand rejected under 35 USC § 103(a) over US patent number 5,136,647 to Haber et al. (hereinafter "Haber")

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in view of US patent number 6,006,227 to Freeman et al. (hereinafter "Freeman").

The claims presented for appeal are found in the attached Appendix of Appealed Claims.

IV. Status of Amendments

The application was initially filed on May 7, 1999, including claims 1-21. In reply to a first Office Action, which was mailed on May 1, 2003, a Response was filed on July 21, 2003. A final Office Action was mailed on December 17, 2003, and a Response was filed on February 5, 2004. An Advisory Action was mailed on February 19, 2004, indicating that the request for reconsideration was considered but did not place the application in condition for allowance. A Notice of Appeal was filed on March 9, 2004.

V. Summary of Invention

One embodiment of Appellant's invention is directed to a method for time-stamping and managing electronic documents. Respective time-stamp certificates are obtained for a plurality of documents, and the documents and the certificates have associated identifiers (FIG. 2, 112, 114, 162; p. 6, l. 26 - p. 7, l. 8; FIG. 3, 204, 226; p. 8, ll. 23-28; p. 10, ll. 7-13). A database of document identifiers and associated certificate identifiers is built (FIG. 1, 116; FIG. 2, 116; FIG. 232; p. 10, ll. 14-17), and the documents and certificates are stored (FIG. 3, 234; p. 10, ll. 17-19).

VI. Issues for Review

Issue 1: Is the §103(a) rejection of claims 1-21 proper when the asserted *Haber* and *Freeman* references fail to teach or suggest every limitation of the claims, when the rejection fails to cite evidence of motivation, and there is no apparent likelihood of successfully combining the references?

VII. Grouping of Claims

For purposes of this appeal, claims 1 and 17 are in group I; claims 3 and 20 are in group II; claims 5 and 19 are in group III; and each of claims 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 18 are in group IV. The claims of the different groups do not stand or fall together, and the claims in group IV do not stand or fall together.

VIII. Argument

Issue 1: The §103(a) rejection of claims 1-21 is improper because the asserted *Haber* and *Freeman* references fail to teach or suggest every limitation of the claims, the rejection fails to cite evidence of motivation to combine the references, and there is no apparent likelihood of successfully combining the references.

In order to establish a *prima facie* case of obviousness, the asserted prior art references must teach or suggest all the claim limitations, evidence must be provided to support a motivation for modifying the reference to arrive at the claimed invention, and there must be a reasonable likelihood that the references could be successfully combined. The final Office Action and preceding Office Action (hereinafter the "Office Actions") fail to meet these requirements.

Claim 1 includes limitations of obtaining respective time-stamp certificates for a plurality of documents. The documents and the certificates have associated identifiers. A database of document identifiers and associated certificate identifiers is built, and the documents and the certificates are stored. The Office Action fails to show all the limitations.

For example, no showing has been made that any of the cited references teach or suggest the limitations of building a database of document identifiers and associated certificate identifiers. It is respectfully submitted that the Office Actions do not show that these limitations are suggested by either *Haber* or *Freeman*. Specifically, the Office Actions

fail to recognize the distinctions between a *document* versus a *document identifier* and a *time-stamp certificate* versus a *certificate identifier*.

The terms *document* and *document identifier* and *time-stamp certificate* and *certificate identifier* are all used distinctly in the claims. Furthermore, the figures and written description make clear that these terms refer to distinct, but related, information. A database is built using the document identifiers and associated certificate identifiers, and additionally the documents and certificates are stored. The claimed use of document identifiers and certificate identifiers has not been shown to have been suggested by the Haber-Freeman combination.

Haber is cited as teaching the generating of a tamper-proof time seal that establishes an author's claim to the temporal existence of a document. Freeman is cited as teaching storing documents in chronologically ordered streams. The Office Actions allege that Freeman's element 100 in FIG. 1 suggests the specific claim limitations of the claimed database including document identifiers and associated certificate identifiers. However, the cited element 100 of Freeman's FIG. 1 shows a browse card that helps a user identify a document by providing the user some idea of the document's contents in a small window. The browse card appears when the user touches a document in the stream display and may include the first non-trivial words in the document and apparently a timestamp. (col. 7, l. 64 - col. 8, l. 10). Freeman appears to show the documents and timestamps, but not distinct document identifiers and distinct timestamp certificate identifiers. Furthermore, Haber suggests a tamper-proof seal, not any separate identifier that is associated with the seal. Therefore, the Office Actions have not shown a suggestion of a database of timestamp certificate identifiers that are associated with document identifiers.

The Office Actions further allege that "in order to retrieve any specific item from a database, there must exists

[sic] an identifier to locate the item, since a database, by definition is storage of retrievable items." It is respectfully submitted that the Office Actions read more from Freeman than Freeman actually teaches. A word search of Freeman does not appear to reveal use of the terms "database" or "data base". Thus, the Office Actions are apparently premised on the mistaken assumption that Freeman teaches a database. Instead of a database, Freeman may use a flat file to store the stream of documents and use end-of-file markers to demarcate files instead of file identifiers. Furthermore, Freeman explains that naming a file when a file is created is unneeded overhead (col. 1, ll. 52-54). Thus, Freeman teaches away from use of document identifiers.

The Office Actions have clearly failed to show a teaching or suggestion of a database of document identifiers and associated certificate identifiers, and therefore, not shown all the limitations of claim 1 to be suggested by the Haber-Freeman combination.

Claim 17 is a system claim, and to the extent that the limitations of claim 17 are similar to limitations of claim 1, the Office Actions have not shown all the limitations of claim 17 to be suggested by the Haber-Freeman combination.

The alleged motivation for combining the references is that "it would facilitate organized storage of certified documents, thereby enabling an administrator to verify an audit trail" and Freeman "explicitly pointed out the advantage of the database used in the invention and the visual display of chronological metaphor of documents (col. 2, lines 1-45). Given that a person of ordinary skill in the art with the Haber et al. patent that taught the 'time-stamping' and storage of digital documents would have appreciated the benefit of the features taught by the prior art of Freeman et al." The alleged motivation does not support a *prima facie* case of obviousness.

Not only does the alleged motivation fail on the basis of mistaken assumptions, but the alleged motivation also fails

because it states no more than a general conclusion. As explained above, the mistaken assumption is that Freeman teaches a database. Freeman does not appear to reference a database, and the stream storage of documents may be in the form of a flat file. Thus, the reference to Freeman's alleged database does not support a motivation to combine Freeman with Haber.

The alleged motivation also fails because no more than general conclusions are provided, and the conclusions appear to be based on hindsight. Specifically, the alleged facilitating organized storage of certified documents is a conclusion that is unsupported by any evidence. The Office Actions have not cited any teaching from Haber that might indicate a need for any organization; Haber appears to be limited to an approach for time-stamping a digital document. Furthermore, this alleged motivation appears to be based on the teachings of the present invention rather than the prior art. For example, the present invention supports ease of tracking of multiple documents and the associated time-stamp certificates (p. 2, ll. 24-32). The Office Actions appear to improperly use this aspect of the present invention as evidence of a motivation to combine Freeman with Haber.

The Office Actions further allege, without explanation, that a Haber-Freeman combination would enable an administrator to verify an audit trail. However, no explanation is provided as to what verification is to be performed or what the intended audit trail entails. Furthermore, neither Haber nor Freeman, in any apparent manner, discuss either audit trails or verification thereof. The rationale to "verify an audit trail" is vague and ambiguous, and its relation to the specific claim limitations is neither explained in the rejection nor understandable without guesswork. Furthermore, the rejection fails to provide any evidence from either Haber or Freeman that organizing the certified documents according to the claim limitations would be beneficial for verifying audit trails. The alleged motivation, therefore, is no more

than a conclusion without any supporting evidence.

Addressing the "rigorous ... requirement for a showing of the teaching or motivation to combine prior art references," the Court of Appeals for the Federal Circuit has stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, (citations omitted), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." (citation omitted) *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The alleged motivation is merely a broad conclusory statement of purported objectives. The alleged motivation lacks clear and particular reasons that would lead one of ordinary skill in the art to modify specific teachings of Haber with those of Freeman. Furthermore, it is not apparent, nor has any evidence been provided, that modifying Haber with the teachings of Freeman would have a reasonable likelihood of success. Therefore, the alleged motivation is insufficient to support *prima facie* obviousness.

Claims 2-16 and 18-21 depend directly or indirectly from either independent claim 1 or independent claim 17. The limitations of these claims are not thought to be suggested by either of Haber or Freeman, and the Office Actions do not recite teachings of Haber or Freeman as suggesting the limitations of these claims. Furthermore, no further motivations have been alleged for combining Freeman with Haber relative to these claims. Therefore, *prima facie* obviousness has not been established for claims 2-16 and 18-21.

For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness for the claims in groups I, II, III, and IV. Accordingly, Appellant submits

that the §103 rejection is improper and the rejection must be withdrawn.

Claims 3 and 20 in group II are separately patentable over the claims in the other groups because the limitations of the claims in the other groups (other than group I) are not necessarily present in claims 3 and 20, and the limitations of constructing chronologically ordered sets of documents in accordance with user specified relationships are not necessarily present in the claims of the other groups (other than claim 5 in group IV) nor are the limitations taught by the prior art. Furthermore, the limitations of claims 3 and 20 are not obvious extensions of the claims in group I.

Claims 5 and 19 in group III are separately patentable over the claims in the other groups because the limitations of the claims in the other groups (other than group I) are not necessarily present in claims 5 and 19, and the limitations of associating a subject with the document identifiers in the database are not necessarily present in the claims of the other groups, nor are the limitations taught by the prior art. Furthermore, the limitations of claims 5 and 19 are not obvious extensions of the claims from which they depend.

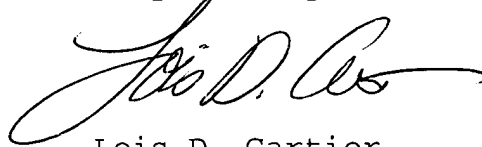
Claims 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 18 are separately patentable over the claims in the other groups because the limitations of the claims in the other groups (other than group I) are not necessarily present in these claims, and the numerous different limitations of these claims are not necessarily present in the claims of the other groups. The limitations of these claims are not taught by the prior art, and the limitations are not obvious extensions of claims from which they depend. Furthermore, each claim in group IV is separately patentable over the other claims in group IV because no claim in the group, other than by dependency, necessarily includes the limitations of another claim in the group, nor is any claim in the group an obvious extension of another claim in the group.

IX. Conclusion

In view of the above, Appellant believes the claimed invention to be patentable. The Office Action makes incomplete and erroneous findings of fact in the various combinations of references and fails to satisfy the requirements for establishing a *prima facie* case of obviousness. These mistakes are the basis of erroneous conclusions of law pertaining to non-allowability of the claims.

Claims 1-21 remain for consideration. Appellant respectfully requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

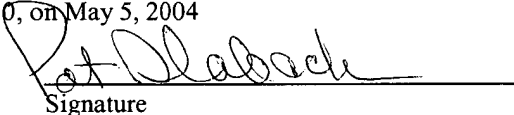
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patent, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 5, 2004

Pat Slaback
Name


Signature

APPENDIX OF APPEALED CLAIMS (09/307,620)

1. (Original) A method for time-stamping and managing electronic documents, comprising:

obtaining respective time-stamp certificates for a plurality of documents, the documents and the certificates having associated identifiers;

building a database of document identifiers and associated certificate identifiers; and

storing the documents and the certificates.

2. (Original) The method of Claim 1, further comprising chronologically linking related documents by date and time of certification.

3. (Original) The method of Claim 1, further comprising constructing chronologically ordered sets of documents in accordance with user specified relationships.

4. (Original) The method of Claim 1, further comprising:
reading textual description information pertaining to the documents; and

associating the description information with the document identifiers in the database.

5. (Original) The method of Claim 1, further comprising associating a subject with the document identifiers in the database.

6. (Original) The method of Claim 3, further comprising associating a time-stamp with the document identifiers in the database.

7. (Original) The method of Claim 1, further comprising obtaining the certificates from an outside agency.

8. (Original) The method of Claim 1, further comprising soliciting from a user a document identifier for a document to certify.

9. (Original) The method of Claim 8, further comprising presenting a browse mode to a user for selection of the document to certify.

10. (Original) The method of Claim 8, further comprising soliciting from a user a description of the document to certify.

11. (Original) The method of Claim 8, further comprising soliciting from a user a subject to associate with the document to certify.

12. (Original) The method of Claim 11, further comprising presenting a browse mode to a user for selection of the subject.

13. (Original) The method of Claim 12, further comprising creating a new subject in response to user input.

14. (Original) The method of Claim 8, further comprising soliciting from a user a thread identifier to associate with the document.

15. (Original) The method of Claim 14, further comprising presenting a browse mode to a user for selection of the thread.

16. (Original) The method of Claim 15, further comprising creating a new thread in response to user input.

17. (Original) A system for time-stamping and managing electronic documents, comprising:

a document manager configured and arranged to generate requests for time-stamp certificates for electronic documents, store the documents and corresponding time-stamp certificates, and generate document identifiers and certificate identifiers that respectively correspond to the documents and time-stamp certificates;

a certificate generator coupled to the document manager, and configured and arranged to generate time-stamp certificates in response to the requests from the document manager; and

a database coupled to the document manager and including associations of document identifiers and certificate identifiers generated by the document manager.

18. (Original) The system of Claim 17, further comprising a certification interface coupled to the document manager and further coupled to the certificate generator via a network, and configured and arranged to transmit the requests from the document manager to the certificate generator and the time-stamp certificates from the certificate generator to the document manager.

19. (Original) The system of Claim 17, wherein the database further includes associations of subjects with the document identifiers.

20. (Original) The system of Claim 17, wherein the database further includes one or more threads indicating chronological relationships between the documents.

21. (Original) The system of Claim 17, wherein the database further includes:

associations of subjects with the document identifiers;

one or more threads indicating chronological
relationships between the documents:

textual descriptions of the documents; and
time-stamps for the documents.